

Attorney Docket No.: 42390.P9234

Application No.: 09/671,957

Page 9

REMARKS

Claims 1-9, 13-18, and 30-38 remain pending. Claims 10-12, 19-29, and 39-41 have been canceled. Claims 13-15 have been amended.

In the Office Action, the Examiner required restriction among the following groups of claims:

- I. Claims 10-21 and 39-41.
- II. Claims 7-9 and 36-38.
- III. Claims 22-29.
- IV. Claims 1-6 and 30-35.

Applicant provisionally elects Group IV, claims 1-6 and 30-35, with traverse.

As an initial matter, and contrary to page 3 of the Office Action, the claims in Groups I-IV have not "acquired a separate status in the art." For example, claims 4 (from Group IV), 7 (from Group II), and 13 (from Group I) all recite "a computer implemented method," and not the separate labels attributed to Groups I, II, and IV on page 2 of the Office Action. With regard to the first of these labels, "user requested video" (for Group I), claim 13 recites neither a user, nor a variant of the verb "to request." Thus, the classification of Group I based on the mis-labeling of the claims in this group as "user requested video" is in error and improper.

Similarly, with regard to the second of these labels, "defining a region of interest using substreams" (for Group II), claim 7 recites that "the substream correspond[s] to a region of interest (ROI)." A cursory reading of claim 7 shows that it is directed to creating a substream corresponding to an ROI, and not "defining a region of interest using substreams" as alleged in

the Office Action. Thus, the classification of Group II based on the mis-labeling of the claims in this group as "defining a region of interest using substreams" is in error and improper.

At least from the above-two examples, it is apparent that the labels applied to Groups I-IV are mis-descriptive. Any classification differences based on these mis-descriptions of Groups I-IV are improper, and are do not accurately reflect the similar classification of claims from Groups I, II, and IV. For at least these reasons, and for the reasons below, Applicant submits that at least Groups I, II, and IV have not acquired a separate status in the art, and should be examined together.

Nor are Groups I-IV distinct, as alleged on page 2 of the Office Action. Because, as explained above, the groups are mis-labeled, the conclusory statements on pages 2-3 are of no value in demonstrating distinctness. That is, alleging that certain groups have separate utility "not in the user requested video environment" is irrelevant where, as explained above, Group I simply does not recite "user requested video." Nor, as a matter of evidence, are the conclusory statements on pages 2-3 sufficient to show distinctness, because they do not address the *language* of any of the pending claims. Hence, the Examiner has failed to make a *prima facie* showing of the distinctness of Groups I-IV.

Further, Applicant submits that Group IV is not distinct from Group I for the following reasons. With reference to claims 4 (from Group IV) and 13 (from Group I), Applicant notes that the "decoding a picture . . . , decoding at least the set of slices . . . , and decoding at least the set of macroblocks . . ." elements of claim 4 define similar subject matter to the "decoding a picture . . . , selecting a Region of Interest . . . , and constructing a new MPEG picture . . ."

Attorney Docket No.: 42390.P9234

Application No.: 09/671,957

Page 11

elements of claim 13. Because of the similar subject matter between claims 4 and 13, Groups I and IV are related as AB_{sp} and B_{sp}, and restriction is not proper between Groups IV and I (see MPEP 806.05(c)).

Also, Applicant submits that Group II is not distinct from Group I for the following reasons. With reference to claims 7 (from Group II) and 13 (from Group I), Applicant notes that the "creating an MPEG compliant substream . . ." element of claim 7 defines similar subject matter to the "decoding a picture . . . , selecting a Region of Interest . . . , and constructing a new MPEG picture . . ." elements of claim 13. Because of the similar subject matter between claims 7 and 13, Groups I and II are related as AB_{sp} and B_{sp}, and restriction is not proper between Groups I and II (see MPEP 806.05(c)). For at least these reasons, Groups II and IV are not distinct from Group I as alleged¹, and should be examined together.

Although cancellation of claims 22-29 has rendered Group III moot, Applicant still traverses the separate classification thereof, on the grounds that the claims in Group III were also mis-characterized, and it is not at all clear how an apparatus in Group III can be a subcombination of a method in Group I. The restriction of Group III should be withdrawn by the Examiner as a matter of record.

Because Groups I, II, and IV have not acquired a separate status in the art, and because these groups are not distinct, all remaining claims in Groups I, II, and IV should be examined together. The cancellation of claims 10-12, 19-29, and 39-41 also lessens the burden on the

¹ Distinctness between Groups II and IV was not alleged.

Attorney Docket No.: 42390.P9234
Application No.: 09/671,957
Page 12

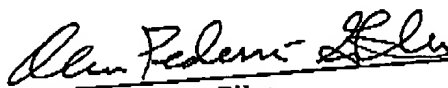
Examiner in doing so. Reconsideration and examination of pending claims 1-9, 13-18, and 30-38 is respectfully requested.

In the event that any outstanding matters remain in this application, Applicant requests that the Examiner contact Alan Pedersen-Giles, attorney for Applicant, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

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